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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IWAO HATANAKA

Appeal 2008-2561
Application 09/781,615
Technology Center 2100

Decided:¹ February 6, 2009

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

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I. STATEMENT OF CASE

Appellant appeals the Examiner's final rejection of claims 1-8 under 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b)(2002).

A. INVENTION

According to Appellant, the invention relates to incorporating one or more legacy software applications into a distributed data processing system such as may be found in a client-server environment (Spec. 3, ll. 3-5).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1. A system for integrating a legacy application into a distributed data processing environment, the system comprising:

a legacy application located at a server coupled to a network; and

an Enterprise JavaBean (EJB) wrapper surrounding the legacy application, said EJB wrapper including an interface which allows for the distributed processing of logical components of the legacy application by a plurality of different processors over the network, wherein the EJB interface allows for the distributed processing and the legacy application retains its conventional processing.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Seacord, *A Survey of Black-Box Modernization Approaches for Information Systems*, IEEE Xplore (2000).

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Sintas, *Does Java pass for reference or pass by value?* JavaWorld, (2000), available at http://www.javaworld.com/javqa/2000-05/03-qa-0526-pass_p.html.

Dictionary of Computing, Fourth Ed., Oxford University Press (Computing), (1996).

Claims 1, 3, and 5 stand rejected under 35 U.S.C. § 102(a) over the teachings of Seacord;

Claims 2 and 4 stand rejected under 35 U.S.C. § 103(a) over the teachings of Seacord in view of Sintas;

Claims 6 and 8 stand rejected under 35 U.S.C. § 103(a) over the teachings of Seacord in view of Computing; and

Claim 7 stands rejected under 35 U.S.C. § 103(a) over the teachings of Seacord in view of Computing and Sintas.

We AFFIRM.

II. ISSUE

The issue is whether Appellant has shown that the Examiner erred in finding that claims 1, 3, and 5 are anticipated under 35 U.S.C. § 102(a) over the teachings of Seacord. The issue turns on whether Seacord discloses “an Enterprise JavaBean (EJB) wrapper surrounding the legacy application, said EJB wrapper including an interface which allows for the distributed processing of logical components of the legacy application by a plurality of

different processors over the network” (claim 1), and “providing an index to the components and the interface” (claim 3).

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Seacord

1. Seacord discloses modernization approaches for information systems (p. 173, col. 1, Abstract).
2. The information systems include enterprise information systems that are large, heterogeneous, distributed, evolving, dynamic, long-lived, mission critical, systems (p. 173, col. 2, Introduction).
3. One modernization approach includes component wrapping, including wrapping using Enterprise JavaBeans (EJB) (p. 180, col. 1-2, 3.3.3 Component Wrapping).
4. The re-implemented bean maintains the same interfaces provided by the wrapper bean (p. 181, col. 1, 3.3.3 Component Wrapping).
5. A single point of contact to the legacy system is built, wherein all the communication knowledge in a single software artifact is centralized (p. 180, col. 2, 3.3.3 Component Wrapping).

IV. PRINCIPLES OF LAW

35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (citations omitted).

The *claims* measure the invention. *See SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). “[T]he PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). “Moreover, limitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

Of course, anticipation “is not an ‘ipsissimis verbis’ test.” *In re Bond*, 910 F.2d 831, 832-33 (Fed. Cir. 1990) (citing *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479 n.11 (Fed. Cir. 1986)). “An anticipatory reference . . . need not duplicate word for word what is in the

claims." *Standard Havens Prods., Inc., v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369 (Fed. Cir. 1991).

V. ANALYSIS

Claim 1

Regarding claim 1, in the Appeal Brief, Appellant argues that "Seacord fails to teach or suggest, *inter alia*, an 'interface which allows for the **distributed processing of logical components of the legacy application by a plurality of different processors over the network**'" (App. Br. 3). However, the Examiner finds that Seacord discloses such limitation (Ans. 4 and 8-10). Thus, the issue that we address on appeal is whether Seacord discloses "an Enterprise JavaBean (EJB) wrapper surrounding the legacy application, said EJB wrapper including an interface which allows for the distributed processing of logical components of the legacy application by a plurality of different processors over the network" (claim 1).

We begin our analysis by giving the claims their broadest reasonable interpretation. *See In re Bigio* at 1324. Furthermore, our analysis will not read limitations into the claims from the specification. *See In re Van Geuns* at 1184. It is the Appellant's burden to precisely define the invention. *See In re Morris* 127 F.3d 1048, 1056 (Fed. Cir. 1997). Appellant's claims simply do not place any limitation on what "distributed" processing means,

includes or represents, other than that the processing is “by a plurality of different processors over the network” (claim 1).

We generally agree with the Examiner’s finding that Seacord discloses the claimed elements on appeal beginning at page 4 of the Answer, and including the Examiner’s corresponding responsive arguments beginning at page 8 of the Answer. As the Examiner finds, “one of ordinary skill in the art would recognize Enterprise JavaBeans are a distributed processing technology” and that “[s]ervers, software external to servers and the clients using servers provide a plurality of processors and therefore distributed processing” (Ans. 9).

Seacord discloses modernizing legacy systems using an approach such as wrapping using Enterprise JavaBeans (EJB) (FF 1 and 3). The approach is used to modernize distributed information systems (FF 2), wherein the interfaces in the distributed system are maintained (FF 4).

We find that the EJB component wrapping approach of Seacord includes using an EJB wrapper to surround a legacy application. We further find that such interface maintained in the distributed system to be an interface which allows for distributed processing. We thus agree with the Examiner that Seacord discloses “an Enterprise JavaBean (EJB) wrapper surrounding the legacy application, said EJB wrapper including an interface which allows for the distributed processing of logical components of the legacy application by a plurality of different processors over the network” as claimed (claim 1).

Appellant also contends that the Examiner alleges “**without any supporting evidence**” and thus, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning” (App. Br. 4). However, the Examiner is not relying on the inherency theory. As discussed above, we find that Seacord teaches an “interface which allows for the distributed processing of logical components of the legacy application by a plurality of different processors over the network” (FF 2 and 4).

Accordingly, we conclude that the Appellant has not shown that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 102(a).

Claim 3

As to claim 3, Appellant also argues that “Seacord fails to teach or suggest ‘providing an index to the components and the interface’” (App. Br. 5). However, the Examiner finds that “under the broadest reasonable interpretation, the ‘single point of contact’ discussion [of Seacord]... indicates Appellant’s claimed ‘providing an index to the components and the interface’” (Ans. 12). Thus, the issue that we address on appeal is whether Seacord discloses “providing an index to the components and the interface” (claim 3).

Appellant’s claims simply do not place any limitation on what “index” means, includes or represents. We give the term “index” its ordinary meaning of “something that serves to point out.”

Seacord discloses using a single point of contact to the legacy system (FF 5). We find that such single point of contact is something that serves to

point out components and interface. That is, to be an anticipatory reference, Seacord need not duplicate word for word what is in the claims. *See Standard Havens Prods, Inc., v. Gencor Indus., Inc.*, 953 F.2d at 1369. We thus agree with the Examiner that Seacord discloses “providing an index to the components and the interface” (claim 3).

Appellant has not shown, in the Appeal Brief or in any Reply Brief, any argument to dispute that the Examiner has correctly shown where all the claimed elements appear in the prior art.

Claims 2, and 4-8

As to claim 2, and 4-8, Appellant does not provide separate arguments with respect to the rejection of independent claim 6, and dependent claims 2, 4, 5, 7, and 8 depending from independent claims 1, 3, and 6, respectively. As discussed above, we find no deficiency regarding Seacord in the rejections of claims 1 and 3. Since Appellant has not provided separate arguments, we conclude that the Appellant has not shown that the Examiner erred in rejecting claims 1, 3, and 5 over the teachings of Seacord alone; claims 2 and 4 over the teachings of Seacord in view of Sintas; claims 6 and 8 over the teachings of Seacord in view of Computing; and claim 7 over the teachings of Seacord in view of Computing and Sintas.

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VI. CONCLUSIONS OF LAW

- (1) Appellant has not shown that the Examiner erred in finding that claims 1, 3, and 5 are anticipated by the teachings of Seacord.
- (2) Appellant has not shown that the Examiner erred in finding that claims 2 and 4 are unpatentable over the teachings of Seacord in view of Sintas.
- (3) Appellant has not shown that the Examiner erred in finding that claims 6 and 8 are unpatentable over the teachings of Seacord in view of Computing.
- (4) Appellant has not shown that the Examiner erred in finding that claim 7 is unpatentable over the teachings of Seacord in view of Computing and Sintas.
- (5) Claims 1-8 are not patentable.

VII. DECISION

The Examiner's decision rejecting claims 1, 3, and 5 under 35 U.S.C. § 102(a) and rejecting claims 2, 4, and 6-8 under 35 U.S.C. § 103(a) are affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

rwk

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